

**REMARKS**

Applicants appreciate the courtesy extended by Examiner Jaime Holliday and Supervisory Patent Examiner Joseph Feild in granting a telephone interview on Wednesday, January 10, 2007, to the Applicants' representative, Safet Metjahic. During the interview, Applicants' representative explained the patentable distinctions between the claimed subject matter and the applied documents of WAESTERLID, EIDEN et al., YEAGER et al., and FORSYTH. In this regard, Applicants' representative explained the patentable distinctions as discussed below.

Applicants note that this Amendment is being submitted after a Final Office Action has been mailed. Applicants respectfully request entry and consideration of this Amendment, including the amendments provided herein, and believe such entry and consideration is proper. Applicants also respectfully request the Examiner to reconsider and to withdraw all of the outstanding rejections made in the outstanding Final Office Action, and to allow the application into mature to a U.S. letters patent. Applicants believe that such action is proper and necessary, for at least the reasons provided below.

Applicants recognize that Applicants cannot, as a matter of right, amend any finally rejected claims. However, Applicants also recognize that any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Since the herein provided amendments to claims 1, 8-17 and 19-26 have been made in order to place the application in condition for allowance by amending the claims to further clarify the claimed subject matter, this Amendment should be entered. No prohibited new matter has been added by any of the amendments contained herein.

Upon entry of the present Amendment, claims 1-26 will be pending, of which claims 1, 8-17 and 19-26 will have been amended in order to expedite prosecution. However, Applicants submit that the amendments should not be construed as admissions to the propriety of the Examiner's rejection.

In the above noted Final Official Action mailed October 19, 2006, the Examiner rejected claims 11, 15, 21 and 25 under 35 U.S.C. 102(b) as being anticipated by WAESTERLID. The Examiner further rejected claims 1-6, 8-10, 13, 14, 17-20, 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over WAESTERLID in view of EIDEN et al. The Examiner also rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over WAESTERLID in view of EIDEN et al. and in further view of YEAGER et al. The Examiner also rejected claims 12, 16, 22 and 26 under 35 U.S.C. 103(a) as being unpatentable over WAESTERLID in view of FORSYTH. Applicants respectfully traverse all rejections and request that the Examiner reconsider the rejections, withdraw the same, and indicate the allowability of all pending claims, *i.e.* claims 1-26, in the next Office correspondence.

Applicants traverse the rejection of claims 11, 15, 21 and 25, under Section 102, as being anticipated by WAESTERLID for at least the reasons provided below. Applicants submit that WAESTERLID fails to teach or suggest each and every feature of the present invention as recited in these claims. Further, Applicants, upon entry of this Amendment, will have amended claims 11, 15, 21 and 25, as suggested by Examiner Holliday during the above-noted telephone interview, to further clarify that the received contact mail is received from the mail exchange terminal devices of existing members other than a specific member that sent an invitation or participation mail to the newly joining member.

As explained by Applicants' representative during the above-noted telephone interview on Wednesday, January 10, 2007, WAESTERLID fails to teach or suggest wherein an entry in the member list is generated from member information extracted from the received contact mail, which is currently recited in each of claims 11, 15, 21 and 25. Moreover, upon entry of this Amendment, Applicants submit that WAESTERLID fails to teach or suggest that the received contact mail is received from existing members other than the specific member, as recited in claims 11, 15, 21 and 25 as amended herein.

As explained during the above-noted telephone interview, WAESTERLID describes a mobile-communication system that may be used in either a server-client or peer-to-peer communication arrangement, but the preferred arrangement is that of a server-client, as shown, for example, in FIG. 4. See *e.g.*, WAESTERLID at page 10, lines 19 to 21. In either case, the "user creating the affinity group becomes the owner of the group and is referred to as the group administrator" (see *e.g.*, WAESTERLID at page 11, lines 21 to 22). Moreover, "[o]nly the group administrator can send a Membership Request message" to a prospective new member (see *e.g.*, WAESTERLID at page 12, lines 17 to 29).

Further, referring to, *e.g.*, page 10, line 17 *et seq.*, and Figures 6A and 6B, WAESTERLID describes a new member addition process in the communication system. The publication describes a process where a first user sends a message to a messaging server 170 (step 204, FIG. 6A) in order to relay a message to one or more prospective members (step 208, FIG. 6A), whom the first member would like to join an affinity group. WAESTERLID specifies that "[o]nly the group administrator can send a Membership Request message." See WAESTERLID, page 12, lines 28-29. The

Request for Membership message transmitted to the prospective member is illustrated at page 17 of the publication, in Appendix A. Should the prospective member accept membership (step 212, FIG. 6A) by transmitting a Membership Reply Message (page 17, Appendix A), then the prospective member would be added as a new member to a group database (step 216, FIG. 6B) in the server 170. In addition, the new member's client application will create an affinity group database stored it in a memory of the client device, including a record for each member of the affinity group. The server 170 relays the new member's acceptance to the group administrator. A Group Update message is then sent to all members (step 220, FIG. 6B) from server 170. The Group Update message may be generated in either the server 170 or the group administrator's communication device 100, but in either case, the Group Update message containing a list of all members of the group is transmitted from the server 170.

Similarly, in the peer-to-peer communication arrangement of WAESTERLID, the group administrator retains complete control of group membership, as discussed above. However, instead of the server 170 broadcasting a Status Update to all group members, the individual group administrator 180 (peer) will send a Status Update message to every other group member 180 (peer) in the affinity group.

WAESTERLID does not teach or suggest a mail exchange terminal that extracts member information from received contact mail from existing members, and uses the extracted information to assemble a member list in a newly joined member's terminal device. This distinction is further clarified by the amendments to claims 11, 15, 21 and 25 made herein to specify that the received contact mail is received from existing members other than a specific member that sent an invite or invitation mail to a newly joining member, inviting the newly joining member to participate in a group.

Thus, Applicants respectfully submit that claims 11, 15, 21 and 25 have been patentably distinguish over the applied WAESTERLID document. Accordingly, Applicants request withdrawal of the Section 102 rejection of claims 11, 15, 21 and 25 as being anticipated by WAESTERLID, along with an indication of allowability of the claims in the next Official communication.

Applicants further traverse the rejection of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over WAESTERLID in view of EIDEN et al., for at least the reasons provided below. As explained during the above-noted telephone interview, WAESTERLID and EIDEN et al., whether taken alone or in any proper combination, fail to teach or suggest each and every feature of the present invention as recited in these claims. Moreover, Applicants have amended claims 1, 8-10, 13, 14, 17-20, 23 and 24 to further clarify the claimed subject matter. Thus, Applicants respectfully request reconsideration and withdrawal of the Section 103 rejection of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24, and an indication of allowability of the same in the next Office correspondence.

In the above noted Official Action, the Examiner conceded that WAESTERLID fails to disclose that the group member and current members extract newly joined member information. However, the Examiner relies on EIDEN et al. to fill the deficiencies found in WAESTERLID. Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine WAESTERLID and EIDEN et al. However, *arguendo*, even if such a combination were to be possible (and Applicants submit that it is not), Applicants submit the combination would still fail to teach or suggest, alone or in any proper combination, the claimed subject matter of claims 1-26, and particularly claims 1-6, 8-10, 13, 14, 17-20, 23 and 24.

As discussed above, WAESTERLID is directed to a centralized communications system with a server 170 and/or group administrator 180 at the center, controlling all facets of membership. Meanwhile, EIDEN et al. is directed to a peer-to-peer system wherein membership is controlled by majority vote. WAESTERLID's teaching, requiring that "only the group administrator can send a Membership Request message" (WAESTERLID, page 12, lines 28-29), teaches away from EIDEN's decentralized peer-to-peer system where control over membership is distributed amongst the group members. Thus, Applicants submit that one of ordinary skill in the art would not have been motivated, at the time of Applicants' invention, to combine WAESTERLID and EIDEN et al. to arrive at the instant invention as recited, for example, in claims 1-6, 8-10, 13, 14, 17-20, 23 and 24. Accordingly, Applicants submit that absent a motivation to combine the documents in the manner suggested by the Examiner, which is required for a *prima facie* obviousness rejection, the rejection is improper and should be withdrawn.

Assuming *arguendo* that a combination were possible between the WAESTERLID and EIDEN et al. teachings (and Applicants submit such a combination would not be possible because it would destroy the WAESTERLID system), the combination would fail to teach or suggest the recitations of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24. For example, WAESTERLID and EIDEN, whether taken alone or in any proper combination, fail to teach or suggest: "a member information generator that generates entries in a member list stored in the member information storage by extracting the self-member information from the received existing member mail from the plurality of existing member terminals, other than the specific member terminal," as recited, for example, in claim 1; "the newly joining member generates entries in a member list by extracting the self-member information from contact mail received from a plurality of mail exchange

terminal devices of existing members, the existing members being other than a specific member that sent an invite mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 8; "the newly joining member generates an entry in a member list by extracting the member information from the contact mail of the other existing members, other than a specific member that sent an invite mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 10; "the newly joining member generates entries in a member list by extracting the self-member information from the invite mail received from said communications device, the invite mail being received from existing members other than a specific member that sent an invite mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 13; "the mail exchange terminal device of the newly joining member generates entries in a member list by extracting member information from contact mail received from the plurality of mail exchange terminal devices of the existing members, the existing members being other than a member that sent an invite mail to the newly joining member," as recited, for example, in claim 14; "extracting the member information of the existing members from the received contact mail at said terminal device of the new member and storing the extracted member information in said storage as a plurality of entries, wherein each entry is generated in response to an individual contact mail received from an associated individual terminal device of an existing member, other than the specific member," as recited, for example, in claim 17; "whereby the mail exchange terminal device of the newly joining member generates entries in a member list by extracting the self-member information from the invite mail received from said communications device, the invite mail being received from existing members other than a specific member that sent a

participation invitation mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 19; "whereby the mail exchange terminal device of the newly joining member generates entries in a member list by extracting member information from contact mail received from the plurality of mail exchange terminal devices of the existing members, the existing members being other than a specific member that sent an invite mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 20; "whereby the mail exchange terminal device of the newly joining member generates entries in a member list by extracting member information from invite mail received from a plurality of mail exchange terminal devices of existing members, the existing members being other than a specific member that sent a participation invitation mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 23; or "whereby the mail exchange terminal device of the newly joining member generates entries in a member list by extracting member information from contact mail received from the plurality of mail exchange terminal devices of the existing members, the existing members being other than a specific member that sent an invitation mail to said mail exchange terminal device of the newly joining member," as recited, for example, in claim 24.

Applicants submit that WAESTERLID and EIDEN do not teach or suggest, alone or in any proper combination, the above-noted recitations. Instead of recording an entry in a member list using information extracted from mail received from another terminal, WAESTERLID and EIDEN teach transmitting an entire member list to mail exchange terminals. WAESTERLID transmits the Membership Reply and Group Update Messages shown in Appendix A at page 17 from a centralized server 170 to all

communication devices 100. EIDEN transmits "information comprising for instance . . . such as name, address and other contact information of the members" (see paragraph 29, EIDEN) from an existing member to a new member who has requested the information (step 213, FIG. 2, EIDEN). Thus, even if the references were combinable, *i.e.* combined against their respective teachings, Applicants submit that the combination would teach transmitting entire member lists to the peer terminals, thus failing to teach or suggest generating or storing an entry in a member information storage or list using member information extracted from a received mail from another mail exchange terminal, other than a mail exchange terminal that sent an invitation to join to the mail exchange terminal of the newly joining member, as taught by Applicants and recited in each of Applicants' claims 1-6, 8-10, 13, 14, 17-20, 23 and 24. Thus, Applicants respectfully request that the Examiner withdraw the outstanding rejection and indicate the allowability of claims 1-6, 8-10, 13, 14, 17-20, 23 and 24, in addition to the above-discussed claims 11, 15, 21 and 25, which Applicants submit are also patentably distinguished above over the applied documents.

Applicants traverse the rejection of claim 7 under Section 103 as being unpatentable over WAESTERLID in view of EIDEN et al. and in further view of YEAGER et al. Claim 7 depends from claim 1 and is patentably distinguishable for at least the reasons provided above with respect to claim 1, as well as for additional reasons related to its own recitations.

Applicants further traverse the rejection of claims 12, 16, 22 and 26 under Section 103 as being unpatentable over WAESTERLID in view of FORSYTH for at least the reasons provided below. Applicants respectfully request reconsideration and withdrawal of the same, along with an indication of allowability of claims 12, 16, 22 and

26, as well as claims 1-11, 13-15, 17-21 and 23-25 as discussed above, in the next Official communication.

Applicants submit that WAESTERLID fails to disclose the deletion of all member information of members belonging to the group that the terminal is withdrawing from, as provided for in, for example, each of claims 12, 16, 22 and 26. In this regard, Applicants submit that FORSYTH fails to ameliorate the shortcomings of the WAESTERLID document.

WAESTERLID describes a member resignation process in FIG. 7, as well as the corresponding text at page 14 of the publication. The member resignation process, like the member addition process, requires centralized control and updating by server 170. In WAESTERLID, if an existing member wishes to resign from an affinity group, the member sends a Resignation message to the messaging server 170 (step 302, FIG. 7). Upon receiving the Resignation message, the server forwards the Resignation message to the group administrator (step 304, FIG. 7) and removes the resigning member from the group database (step 306, FIG. 7). The group administrator, or server, then generates a Group Update message, which is transmitted to all members to delete the resigning member (step 308, FIG. 7). The Group Update message contains a list of all members, with the exclusion of the resigning member (*see e.g.* page 14, lines 3-4 and Appendix A).

Applicants submit that WAESTERLID fails to teach or suggest, alone or in any proper combination, "a member information deleter that deletes member information of all members from said member information storage belonging to the group in response to the withdrawal mail transmitter transmitting the withdrawal mail, wherein the member information deleter is configured to delete member information in the member

information storage corresponding to the withdrawing member based on the received withdrawal mail," as recited, for example, in claim 12; or "deleting member information of all members from said member information storage belonging to the group in response to the communications device transmitting the withdrawal mail, and deleting member information of said another member from said memory in response to said communications device receiving the withdrawal mail indicating that another member is withdrawing from the group," as recited, for example, in claims 16, 22 and 26.

Applicants submit that FORSYTH fails to ameliorate the shortcomings of WAESTERLID. FORSYTH teaches a communications method and device that enables users to selectively delete Forums from their devices. See e.g., column 6, line 63 to column 7, line 2. Referring to Figure 11, for example, FORSYTH enables the user to access a menu whereby the user can select a Forum to delete. However, Applicants submit that FORSYTH also fails to teach or suggest, alone or in any proper combination, the above-noted recitations of claims 12, 16, 22 or 26.

Applicants submit, even if WAESTERLID and FORSYTH were combined in the manner suggested by the Examiner, the combination of WAESTERLID and FORSYTH would not teach, or suggest, alone or in any proper combination, "a member information deleter that deletes member information of all members from said member information storage belonging to the group in response to the withdrawal mail transmitter transmitting the withdrawal mail, wherein the member information deleter is configured to delete an member information in the member information storage corresponding to the withdrawing member based on the received withdrawal mail," as recited, for example, in claim 12; or "deleting member information of all members from said member information storage belonging to the group in response to the communications

device transmitting the withdrawal mail, and deleting member information of said another member from said memory in response to said communications device receiving the withdrawal mail indicating that another member is withdrawing from the group," as recited, for example, in claims 16, 22 and 26.

Thus, Applicants submit that claims 12, 16, 22 and 26 are patentable over the applied documents and respectfully request that the Examiner withdraw the above rejection and indicate these claims to be allowable along with claims 1-11, 13-15, 17-21 and 23-25.

All pending claims being allowable under all applicable Rules and Laws, and all other matters being fully compliant with all applicable Rules and Laws, Applicants respectfully request that the above captioned application be allowed to mature into a U.S. patent. Based on the above, it is respectfully submitted that this application is now in condition for allowance, and a Notice of Allowance is respectfully requested.

### **SUMMARY AND CONCLUSION**

In view of the foregoing, it is submitted that Examiner's rejections under §102 and 103 in the Final Office Action dated October 19, 2006, should be withdrawn. The present Amendment is in proper form, and none of the references teach or suggest Applicants' claimed invention. Accordingly, Applicants respectfully request timely allowance of the present application.

Applicants note that this Amendment is being made to advance prosecution of the application to allowance, and no acquiescence as to the propriety of the Examiner's rejections is made by the present Amendment. All amendments to the claims which have been made in this Amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Applicants further note the status of the present application as being an after final rejection and with respect to such status believe that there is a clear basis for the entry of the present Amendment consistent with 37 C.F.R. § 1.116. Applicants submit that the amendments made to the pending claims do not raise any new issues requiring further search or consideration by the Examiner. It is also submitted that the present Amendment does not raise the question of prohibited new matter. Moreover, the present Amendment clearly places the present application in condition for allowance.

Accordingly, Applicants respectfully request entry of the present Amendment, and the amendments contained therein, in accordance with the provisions of 37 C.F.R. § 1.116, reconsideration and withdrawal of the outstanding rejections, and indication of the allowability of the claims pending herein.

Should there be any questions regarding this paper or the present application, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,  
Masahiro HORA et al.

A handwritten signature in black ink, appearing to read 'Bruce H. Bernstein', with a long, sweeping horizontal line extending to the right.

Bruce H. Bernstein  
Reg. No. 29,027

Steven Wegman  
Reg. No. 31,438

January 19, 2007  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191